



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/593,316	09/18/2006	Yvonne Heischkel	295796US0PCT	7016
22850	7590	09/30/2010		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER BALASUBRAMANIAN, VENKATARAMAN	
			ART UNIT 1624	PAPER NUMBER
			NOTIFICATION DATE 09/30/2010	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com  
oblonpat@oblon.com  
jgardner@oblon.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/593,316	<b>Applicant(s)</b> HEISCHKEL ET AL.	
	<b>Examiner</b> /Venkataraman Balasubramanian/	<b>Art Unit</b> 1624	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission, which included addition of new claims 19-31 and amendment to claims 1-9 and 11-18, filed on 08/06/2010 has been entered. Claims 1-31 are pending. In view of applicants' response, the 112 second paragraph rejection of claims 13-15 has been obviated. In addition, the 112 first paragraph rejection made in the previous office action has obviated. However, the following second paragraph rejections and double patenting rejections made in the previous office action are maintained. In addition, new grounds of rejections are applied to currently pending claims.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4-12,15-18 and 25-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1. The amended claim 4 and its dependent claims 5, 9, 11, 25, 26 are indefinite as it is not clear what triazine carbamate is embraced in the amended claim 4. As recited it

Art Unit: 1624

is product by process claim and since the structure of triazine carbamate are not shown or defined, it is not clear what is structural make-up of the triazine is. For search and examination purpose scope of claims 1, 2 and 3 is used.

This rejection is same as made in the previous office action. Applicants' traversal is not persuasive. The structural make-up of the triazine carbamate and triazine urea is not shown or defined. As recited, one is asked to guess the structural make-up of the product by reacting compound IV or 2,4,6-trisisocyanato-triazine with an alcohol or amine and hence claim 4 is indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More specifically, the reaction of a compound containing amino group reaction assuming the amino group is the reactant will results in triazine urea and or a triazine containing one more carbamate and urea group. Thus the structural make-up of the radiation curable triazine carbamate claimed in claim 4 and 5 remains unknown.

2. The amended claims 6 and 7 and their dependent claims 27-30 are indefinite as it is not clear what triazine carbamate is embraced in the amended claims 6 and 7. As recited, the preamble of the claims recite a process for preparing compound of formula I in claim 6 and process for preparing compound of formula I, II, and III in claim 7. As recited, one is asked to guess the structural make-up of the product by reacting compound IV in claim 6 and by reacting compound IV or 2, 4, 6-trisisocyanato-triazine with an alcohol or amine in claim 7. Hence claims 6 and 7 are indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More specifically, the reaction of a compound containing amino group

Art Unit: 1624

reaction assuming the amino group is the reactant will results in triazine urea and or a triazine containing one more carbamate and urea group. Thus the structural make-up of the radiation curable triazine carbamate claimed in claim 6 and 7 remains unknown. For search and examination purpose scope of claims 1, 2 and 3 is used.

3. Recitation of "at least one methacryloyl or acryloyl group is selected from the group consisting of polyether (meth)acrylates, polyesterol (meth)acrylates, urethane (meth)acrylates and epoxy (meth) acrylates renders claim 5 is indefinite as it is not clear what the intended structural make-up of the radiation-curable 1,3,5-triazine carbamate claimed therein. Note methacryloyl and acryloyl group well defined functional groups while polyether (meth)acrylates, polyesterol (meth)acrylates, urethane (meth)acrylates and epoxy (meth) acrylates polymers and do not have the methacryloyl or acryloyl group. As result, the scope of claim 5 is out side the scope of claim 4 which require a methacryloyl and acryloyl group. Hence, claim 5 is an improper dependent claim.

4. The process of claim 8 is vague and unclear as it is not clear how reacting compound of formula with  $Z^1-O-R^1-X^1-H$  as embraced will lead to compound of formula V wherein the second carbamate group has a  $R^2$ .

5. Claims 10, 11 and 16-18 provide for method of the use of compound of claim 1 or claim 2 or claim 4 or claim 8 but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Art Unit: 1624

6. The amended claim 12 is indefinite as it is not clear what triazine carbamate is embraced in the amended claim 12. As recited, the preamble of the claim recites a process for preparing compound of formula I in claim 2. As recited, one is asked to guess the structural make-up of the product by reacting compound IV in claim 12 with an alcohol or an amine. Hence claim 12 is indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More specifically, the reaction of a compound containing amino group reaction assuming the amino group is the reactant will result in triazine urea and or a triazine containing one more carbamate and urea group. Thus the structural make-up of the radiation curable triazine carbamate claimed in claim 12 remains unknown. For search and examination purpose scope of claims 1, 2 and 3 is used.

7. Claim 12 is also an improper dependent claim as it recites a variable group  $R^2$  which is not in claim 2 on which claim 12 is dependent. See choice of alcohols. The scope of claim 12 is therefore outside the scope of claim 2.

8. Claims 11 and 16-18 are indefinite as they recite "dual-curing a composition" without stating what this composition is. Note compounds of claims 1-3 are not recited as dual curing composition and hence it is not clear what this dual-curing is and what composition is dual-curable.

9. Claim 15 is an improper dependent claim as claim 15, which is composition claim, depends on process claim 8. A composition claim cannot depend on process claim

The following is a quotation of the first paragraph of 35 U.S.C. 112:

Art Unit: 1624

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 4-9, 11, 12, 15, 18 and 25-31 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for process for making triazine carbamate of formula I or formula II and III wherein in the groups  $X^1-R^1-O-Z^1$ ,  $X^2-R^2-O-Z^2$  and  $X^3-R^3-O-Z^2$ ,  $R^1$ ,  $R^2$  and  $R^3$  are each independently  $C_1-C_{12}$  alkyl,  $X^1$ ,  $X^2$  and  $X^3$  is oxygen,  $Z^1$ ,  $Z^2$  and  $Z^3$  bear at least one methacryloyl or acryloyl group, by reacting triazine carbamate of formula IV or by reacting 2,4,6-trisocyanato-1,3,5-triazine wherein  $R^4$ ,  $R^5$  and  $R^6$  are each independently  $C_1-C_4$  alkyl with a compound containing a hydroxyl of formula  $H-X^1-R^1-O-Z^1$ ,  $-H-X^2-R^2-O-Z^2$  and  $H-X^3-R^3-O-Z^2$  wherein  $X^1$ ,  $X^2$  and  $X^3$  is oxygen,  $Z^1$ ,  $Z^2$  and  $Z^3$  bear at least one methacryloyl or acryloyl group, does not reasonably provide enablement for process for making triazine carbamate of formula I, formula II or formula III, wherein in the groups  $X^1-R^1-O-Z^1$ ,  $X^2-R^2-O-Z^2$  and  $X^3-R^3-O-Z^2$ ,  $R^1$ ,  $R^2$  and  $R^3$  are each independently  $C_1-C_{12}$  alkyl,  $X^1$ ,  $X^2$  and  $X^3$  is oxygen,  $Z^1$ ,  $Z^2$  and  $Z^3$  bear at least one methacryloyl or acryloyl group, by reacting triazine carbamate of formula IV wherein  $R^4$ ,  $R^5$  and  $R^6$  are each independently  $C_1-C_4$  alkyl with any compound containing a hydroxyl or amino group and at least one methacryloyl or acryloyl group as embraced in claim language. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and hence use the invention commensurate in scope with these claims.

In evaluating the enablement question, following factors are considered. Note In re Wands, 8 USPQ2d 1400 and Ex parte Forman, 230 USPQ 546. The factors include: 1) The nature of the invention, 2) the state of the prior art, 3) the predictability or lack thereof in the art, 4) the amount of direction or guidance present, 5) the presence or absence of working examples, 6) the breadth of the claims, and 7) the quantity of experimentation needed.

1. The nature of the invention and the state of the prior art:

The instant invention of claims 4 and 5 are drawn to a product of undefined structure by reacting compound of formula IV with a compound containing a hydroxyl or amine and at least one methacryloyl or acryloyl group, claims 6 and 12 are drawn to a process of making compound of formula I by reacting compound of formula IV with a compound containing a hydroxyl or amine and at least one methacryloyl or acryloyl group while claims 7 and 8 are drawn to process for making triazine carbamate of formula I, formula II, formula III, formula V and formula VI, by reacting 2,4,6-triisocyanato-1,3,5-triazine with a compound containing a hydroxyl or amine bearing at least one methacryloyl or acryloyl group,

Specification, while enabled enabling for process for making triazine carbamate of formula I or formula II or formula III or formula V or formula VI wherein in the groups  $X^1-R^1-O-Z^1$ ,  $X^2-R^2-O-Z^2$  and  $X^3-R^3-O-Z^2$ ,  $R^1$ ,  $R^2$  and  $R^3$  are each independently  $C_1$ - $C_{12}$  alkyl,  $X^1$ ,  $X^2$  and  $X^3$  is oxygen,  $Z^1$ ,  $Z^2$  and  $Z^3$  bear at least one methacryloyl or acryloyl group, by reacting triazine carbamate of formula IV or wherein  $R^4$ ,  $R^5$  and  $R^6$  are each independently  $C_1$ - $C_4$  alkyl or by reacting 2,4,6-triisocyanato-1,3,5-triazine with a



Art Unit: 1624

compound containing a hydroxyl of formula  $H-X^1-R^1-O-Z^1$ ,  $-H-X^2-R^2-O-Z^2$  and  $H-X^3-R^3-O-Z^2$  wherein  $X^1$ ,  $X^2$  and  $X^3$  is oxygen,  $Z^1$ ,  $Z^2$  and  $Z^3$  bear at least one methacryloyl or acryloyl group, does not reasonably provide enablement for process for making triazine carbamate of formula I or formula II or formula III or formula V or formula VI, wherein in the groups  $X^1-R^1-O-Z^1$ ,  $X^2-R^2-O-Z^2$  and  $X^3-R^3-O-Z^2$ ,  $R^1$ ,  $R^2$  and  $R^3$  are each independently  $C_1$ - $C_{12}$  alkyl,  $X^1$ ,  $X^2$  and  $X^3$  is oxygen,  $Z^1$ ,  $Z^2$  and  $Z^3$  bear at least one methacryloyl or acryloyl group, by reacting triazine carbamate of formula IV wherein  $R^4$ ,  $R^5$  and  $R^6$  are each independently  $C_1$ - $C_4$  alkyl or by reacting 2,4,6-triisocyanato-1,3,5-triazine with any compound containing a hydroxyl or amino group and at least one methacryloyl or acryloyl group as embraced in claim language.

As recited, the scope of the process of the product of claim 4 remains unknown as the final product structure is not recited and disclosed in the claim. Hence, it is not possible to examine the scope of the process or the product. As pointed out before, for search and examination purpose scope of claims 1, 2 and 3 is used.

In addition, all the above process claims, structural make-up of the alcohol is not clearly defined. The reactants for the process are recited as a compound containing a hydroxyl or amino group and at least one methacryloyl or acryloyl group.

Therefore, the processes of claims 4-8 and 12 imply that the reaction of any compound containing a hydroxyl and at least one methacryloyl or acryloyl group with compound of formula IV or 2,4,6-triisocyanato-1,3,5-triazine would occur selectively leading to triazine carbamate of formula I, II III,V or VI for which there is no enabling disclosure. This clearly chemically incorrect as the transesterification and addition to

Art Unit: 1624

isocyanato group embraced in these processes would incorporate the reactant alcohol and unless the alcohol is same as those in the final product, the resultant product would be outside the scope of the product of formula I, II, III, V and VI. Specification has no teaching or suggestion as how to perform such process to arrive the desired final product of formula I, II, III, V and VI.

Similarly, the process of claims 4-8 and 12 embraced triazine carbamate of formula I, II, III, V, and VI by reacting triazine carbamate of formula IV or by reacting 2,4,6-trisocyanato-1,3,5-triazine with a compound containing amino group and at least one methacryloyl or acryloyl group, for which there is no enabling disclosure.

This is again not known in the art and such a reaction is also chemically not possible as reaction of carbamate group with any amine as recited will result in urea group by displacement of the alcohol component of the carbamate group. Similarly, addition of amine to isocyanato group as claimed in process claims 7 and 8 will lead to urea not a carbamate as claimed in these processes.

Specification has no teaching or suggestion as to how to perform said process as embraced in the instant claims to arrive at compound of formula I, II, III, V and VI.

2. The predictability or lack thereof in the art:

Hence the process as applied to the above-mentioned compounds claimed by the applicant is not an art-recognized process and hence there should be adequate enabling disclosure in the specification with working example(s).

3. The amount of direction or guidance present:

Art Unit: 1624

Example illustrated in the experimental section or written description offers no guidance or teachings as to how perform the process of making triazine of formula I, II, III, V and VI with the given choices of variable groups and given choices of alcohols and amines as embraced in the instant invention.

4. The presence or absence of working examples:

Although example 1 shows the process for making triazine carbamate of formula I, it is limited to the process wherein  $X^1-R^1-O-Z^1$ ,  $X^2-R^2-O-Z^2$  and  $X^3-R^3-O-Z^2$  are same and do not include variable choices for  $X^1-R^1-O-Z^1$ ,  $X^2-R^2-O-Z^2$  and  $X^3-R^3-O-Z^2$  alcohols or amines in starting material and final product bearing different  $X^1-R^1-O-Z^1$ ,  $X^2-R^2-O-Z^2$  and  $X^3-R^3-O-Z^2$  and different  $R^4$  and  $R^5$  and  $R^6$

5. The breadth of the claims:

Specification has no support, as noted above, for making compound of formula I, II and III reacting compound of formula IV with various alcohols and amines as embraced in  $R^1$ ,  $R^2$ ,  $R^3$ ,  $X^1$ ,  $X^2$ ,  $X^3$ ,  $Z^1$ ,  $Z^2$  and  $Z^3$  choices. There is no support for the process generically embraced in claims 4-8 and 12 would lead to claimed compound of formula I, II, III, V and VI.

6. The quantity of experimentation needed:

The quantity of experimentation needed would be an undue burden on skilled art in the chemical art since there is inadequate guidance given to the skilled artisan for the many reasons stated above. Even with the undue burden of experimentation, there is no guarantee that one would get the product of desired structure, namely compound of formula I, II, III, V and VI embraced in the instant claims 4-8 and 12.

Also, note MPEP 2164.08(b) which states that claims that read on "... significant numbers of inoperative embodiments would render claims nonenabled when the specification does not clearly identify the operative embodiments and undue experimentation is involved in determining those that are operative.". Clearly that is the case here.

Thus, factors such as "sufficient working examples", the "level of skill in the art and predictability, etc. have been demonstrated to be sufficiently lacking in the case for the instant claims.

Genentech Inc. v. Novo Nordisk A/S (CA FC) 42 USPQ2d 1001, states that "a patent is not a hunting license. It is not a reward for search, but compensation for its successful conclusion" and "[p]atent protection is granted in return for an enabling disclosure of an invention, not for vague intimations of general ideas that may or may not be workable".

MPEP 2164.01(a) states, "A conclusion of lack of enablement means that, based on the evidence regarding each of the above factors, the specification, at the time the application was filed, would not have taught one skilled in the art how to make and/or use the full scope of the claimed invention without undue experimentation. In re Wright, 999 F.2d 1557,1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993)."

That conclusion is clearly justified here. Thus, undue experimentation will be required to make Applicants' invention.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Art Unit: 1624

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 10, 11, and 16-18 is rejected under 35 U.S.C. 101 because the claimed recitation of a method of use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

### ***Double Patenting***

Claim 4 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 1. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim 4 is a product by process claim wherein the product is claimed in claim 1. A product is a product irrespective of how it is made. The processes attributes are independent limitation and do not necessarily define the structural make-up of the product. The claim 4 is not rendered patentably distinct by a process directed to its preparation even though the process may be patentable. Note "Determination of patentability in "product by process" claims is based on product itself, even though such claims are limited and defined by process, and thus product in such claim is unpatentable if it is same as, or obvious from, product of prior art, even if prior product was made by different process" In re Thorpe 227 USPQ 964. Also note In re Brown,

Art Unit: 1624

459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972), the court held that “The lack of physical description in a product by process claim makes determination of the patentability of the claim more difficult, since in spite of the fact that the claim may recite only process limitations, it is the patentability of the product claimed and not of the recited process steps which must be established.”

Hence, if claim 1 were found allowable, claim 4 will be rejected and its dependent claims 5, 9 and 11 will be objected to.

This objection is same as made in the previous office action. Applicants’ traversal is not persuasive. First of all, applicants have not provided any evidence that the scope of claim 4 is not the same as claim 1. Secondly, the structural make-up of the compound of claim 4 is not clearly shown or defined in the claim and is taken as same as claim 1. Thirdly, a product is a product irrespective of how it is made. The structural make-up of the product would be the same irrespective of the processes used to make the product. Applicants have not shown that the structural make-up of the product of claim 4 is different from claim 1. Hence, this objection if applied as a rejection is proper and is maintained.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422

Art Unit: 1624

F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-7, 12-15 and 19-31 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 36-49 of copending Application No. 10/593,308. Although the conflicting claims are not identical, they are not patentably distinct from each other because the triazine carbamates and triazine urea and the process of making them embraced in claims are obvious over the process making triazine carbamate and triazine urea embraced in the earlier filed copending application 10/593,308. More specifically, instant claims 1, 2, 4 and 5 recite triazine carbamate and triazine urea while the process claims 36-49 of earlier filed copending application recites a process of making triazine carbamate and triazine urea which include instant triazine carbamate and triazine urea. One trained in the art in practicing the process of claims 36-49 would make the instant triazine carbamate and triazine urea. See claims 36-49, note the triazine of formula (I) with various variable groups includes instant triazine carbamate and triazine urea. Furthermore, the process of claims 36-49 includes instant process of transesterification and amidation. Hence, it would be obvious to one trained in the art to practice the process with various choices of variables and make triazine carbamate and ureas of formula (I) including instant compounds and expect them to have the use taught therein.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

This rejection is same as made in the previous office action but now includes newly added claims 19-31 and claims 3, 13-15. Applicants' traversal to overcome this rejection is not persuasive for reasons of record.

Applicants' response indicates that they have filed a Terminal Disclaimer to obviate this rejection. However, as per PTO record, no terminal disclaimer has been filed or in record for expediting approval process.

Hence, this rejection is maintained.

### ***Conclusion***

Any inquiry concerning this communication from the examiner should be addressed to Venkataraman Balasubramanian (Bala) whose telephone number is (571) 272-0662. The examiner can normally be reached on Monday through Thursday from 8.00 AM to 6.00 PM. The Supervisory Patent Examiner (SPE) of the art unit 1624 is James O. Wilson, whose telephone number is 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned (571) 273-8300. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAG. Status information for unpublished applications is available through Private PAIR only. For



Art Unit: 1624

more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-2 17-9197 (toll-free).

/Venkataraman Balasubramanian/

Primary Examiner, Art Unit 1624